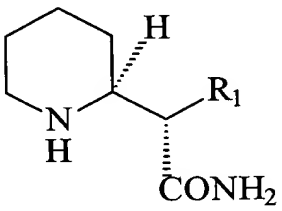
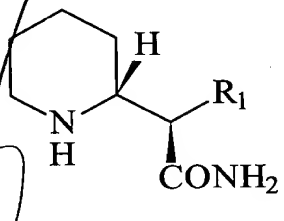
providing a mixture of said *d,l-threo* piperidyl acetamide stereoisomers having formulas:



l-threo



d-threo

wherein R_1 is aryl having about 6 to about 28 carbon atoms; and

reacting said stereoisomers with an acid resolving agent in an organic solvent.

Please cancel claim14.

REMARKS

After entry of the proposed amendment claims 1-8 and 10-13 will be pending.

Claim 14 stands rejected under 35 U.S.C. § 102 (b) as allegedly anticipated by the Jursic *et al.* reference, *Tetrahedron: Asymmetry*, Vol. 5, No. 9, p. 1712 (referred to as the Branko reference in the Office Action.) Although Applicants do not necessarily agree with the rejection, claim 14 has been canceled. Accordingly, the rejection is moot.

Claims 1-8, 10, 11 and 13 stand rejected under 35 U.S.C. § 103 (a) as allegedly obvious over the Jursic reference in view of Berrang, *et al.*, CA 97:38738 ("the Berrang abstract"), Ohashi, *et al.*, CA 104:186157 ("the Ohashi abstract"), and Vanderplas, *et al.*, CA 118:101538 ("the Vanderplas abstract"). As best understood by Applicants, the Office Action appears to assert that the Jursic reference discloses a "process for separating enantiomeric isomers of the claims" using certain chiral resolving agents, that those of ordinary skill in the art would have been motivated to practice the process of Jursic using the chiral resolving agents disclosed in the

Berrang, Ohashi, and Vanderplas abstracts, and that practice of the Jursic process with such resolving agents allegedly would be within the scope of the pending claims. Applicants respectfully request reconsideration of this rejection, as the Office Action mischaracterizes the teaching of the Jursic reference and fails to provide any reason why those of ordinary skill would have been motivated to combine the cited references in the manner suggested.

Although the Office Action suggests that the skilled artisan would be motivated to modify the Jursic reference to employ the resolving agents taught by either the Berrang, Ohashi, or Vanderplas abstracts, these proposed modifications are not suggested or taught by any of the references. In fact, the Jursic reference actually teaches away from such combinations. Significantly, the Jursic reference teaches that the resolving agents employed in its disclosed process should specifically contain an amide group as these types of resolving agents best demonstrate the capabilities of the disclosed method (Jursic reference at page 1712). Significantly, amide groups are not present in any of the resolving agents disclosed in the Berrang, Ohashi, and Vanderplas abstracts. Therefore, one skilled in the art would not be motivated to employ such agents. Given the emphasis which Jursic, *et al.* place on the presence of an amide group in the resolving agents to be used in their disclosed process, there is no reason to believe that those of ordinary skill in the art would have been motivated to practice the Jursic process with resolving agents (such as those disclosed in the Berrang, Ohashi, and Vanderplas abstracts) that do not contain amide groups. Indeed, such a modification would be contrary to the overall teaching of the Jursic reference and, thus, would not have been one that those of ordinary skill would have been motivated to make. *In re Wesslau*, 147 U.S.P.Q. 391 (C.C.P.A. 1965) (a reference is to be considered in its entirety for what it fairly suggests to one skilled in the art).

Since the Office Action is incorrect in its interpretation of the Jursic reference and fails to provide any motivation for its proposed combination of the prior art, Applicants request that the rejection for alleged obviousness under § 103(a) be reconsidered and withdrawn. *In re*

Levengood, 28 U.S.P.Q.2d 1300, 1302 (Pat. Off. Bd. App. 1993) ("an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force that would impel one skilled in the art to do what the patent applicant has done").

Claim 12 stands rejected under 35 U.S.C. § 103 (a) as being allegedly unpatentable over Jursic *et al.* in view of Berrang *et al*, Ohashi *et al.* or Vanderplas *et al.*, further in view of Patrick, *Synthesis of Deuterium-Labelled Methylphenidate, p-Hydroxymethylphenidate, Ritalinic Acid and p-Hydroxyritalinic* Acid, School of Medicine, University of North Carolina.

This rejection assumes that a proper rejection under 35 U.S.C. § 103 (a) has been established. As that is not the case, as discussed above, Applicants request withdrawal of the rejection. The pending claims patentably define Applicants' inventions over the prior art and are believed to be in condition for allowance. An early notice to that effect is, therefore, earnestly solicited.

Respectfully submitted,

Maureen S. Gibbons
Registration No. 44,121

Date: 6/5/00

WOODCOCK WASHBURN KURTZ
MACKIEWICZ & NORRIS LLP
One Liberty Place - 46th Floor
Philadelphia, PA 19103
(215) 568-3100